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10/534,092

01/13/2006

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EXAMINER

LUONG, VINH

ART UNIT

PAPER NUMBER

3682

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/534,092 | Applicant(s) GARNIER, MICHEL | |
| | Examiner Vinh T. Luong | Art Unit 3682 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-41 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 and 29-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 26-28 and 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/24/08; 10/9/07; 1/13/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendments filed on October 9, 2007; December 14, 2007; and March 24, 2008 have been entered.
2. Applicant's election of species of FIGS. 9-11 in the reply filed on May 10, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).
3. Claims 23-25 and 29-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 10, 2007.
4. The amendments filed on October 9, 2007 and December 14, 2007 are objected to because these amendments are not in compliance with 37 CFR 1.121(c). For example, the status identifiers of Claims 23-25 and 29-38 are inaccurate. The instant claims are withdrawn. Therefore, they should be identified as "(Withdrawn)" instead of "(Previously presented)." See MPEP 714.
5. The amendment filed on March 24, 2008 is objected to because the amendment did not identify the application number correctly. The instant application has Application No. 10/534,092, however, the amendment identified it as Application No. 10/534,992.
6. The drawings were received on October 19, 2007. These drawings are not accepted by the Examiner because the amendments to the drawings are not in compliance with 37 CFR 1.121(d) and 1.84. See Notice of Non-Compliant Amendment on January 22, 2008.
7. The drawings were received on March 24, 2008. These drawings are not accepted by the Examiner for the reasons, *inter alia*, listed below:

(a) The replacement drawings are not in compliance with 37 CFR 1.121(d).

For example, 37 CFR 1.121(d) states: “[a]ny changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled “Replacement Sheet.” However, the replacement sheets do not have any label as required;

(b) The drawings are inconsistent with Applicant’s explanation regarding the changes to the drawings.

As noted, 37 CFR 1.121(d) further requires “All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.” In the Amendment filed on October 9, 2007, Applicant explained on pages 11 and 12 that FIG. 9 or 12 has been amended to insert the schematically represented “RADIAL RIBS.” However, amended FIG. 9 or 12 filed on March 24, 2008 does not show the mentioned "RADIAL RIBS"; and

(c) The replacement drawings are not in compliance with 37 CFR 1.84. Please see Form PTO-948 attached.

8. The *original* drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. See Form PTO-948 attached to the Office action on June 6, 2007. For example:

(a) The separated parts in exploded view shown in FIGS. 6 and 12 should be embraced by a bracket to show the relationship or order of assembly. See 37 CFR 1.84(h)(1);

(b) Each part of the invention, e.g., the radial ribs in Claims 28 and 41 and paragraph [0039] of the specification should be designated by a reference character. See 37 CFR 1.84(p) and MPEP 608.01(g);

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(c) The hatching used to indicate section portions of an object must be made by regularly spaced oblique parallel lines spaced sufficiently spaced apart to enable the lines to be distinguished without difficulty. 37 CFR 1.84(h)(3). In the instant case, the hatching in cross-sectional views in FIGS. 3-5, etc. is not made by parallel lines spaced sufficiently apart;

(d) The drawings should show the plane upon which a sectional view such as FIG. 3, 11, 13, or 15 is taken. See 37 CFR 1.84(h)(3); and

(e) The view number should be abbreviated as “FIG.” instead of “fig.” See 37 CFR 1.84(u)(1).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. *The objection to the drawings will not be held in abeyance.*

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9. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature(s) such as the radial ribs in Claims 28 and 41 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

10. The disclosure is objected to because of the informalities, e.g., each part of the invention, such as, the radial ribs in Claims 28 and 41, and paragraph [0039] of the specification should be designated by a reference character. See 37 CFR 1.84(p) and MPEP 608.01(g). Appropriate correction is required.

11. The claims are objected to because they include reference characters, which are not enclosed within parentheses. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

The reference characters, such as, O' and r' to indicate the center and the radius in Claims 22 and 39 should have been enclosed within parentheses.

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 28 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 28 and 41 recite “the retention means (38) comprises radial ribs.” However, the original drawings (FIGS. 9-11) do not show the radial ribs. It is unclear as to how Applicant made/used the radial ribs as claimed on the filing date.

14. Claims 22, 26-28, and 39-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “a pedal body (1) comprising *a rectangular horizontal plate* (2) having an upper surface” (emphasis added) in Claim 22 is inaccurate and/or misdescriptive. For example, *WEBSTER’S II New Riverside University Dictionary 1994* defines “rectangular” as “having right angles.” However, FIG. 9 (or FIG. 1) shows that the rear part of the plate 2 (wherein the locking means 6 is located) does not have right angles. Thus, the plate 2 is not rectangular based on the ordinary and customary meaning of this term. As noted, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). In the instant case, the term “rectangular” is indefinite because the specification does not clearly redefine the instant term. See MPEP 2173.05(a).

The recitation “the support axis being defined as *an axis merging with the front plate and passing through the metatarsus of a cyclist's big toe* when said cyclist is pedalling with said

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cyclist's foot fitted in a cycling shoe interlocked with the cycle pedal" (emphasis added) in Claims 22 and 39 are indefinite because the relationship of the claimed parts, such as, the location of the support axis, the front plate, and the cycle pedal is not based on an objective standard, but on a subjective standard. Whether a particular cycle pedal is covered by the claims or not would depend upon the variable objects, such as, the size, shape, and/or specific build of the toe, the foot, and/or the habit of placing the foot/cyclist shoe on the bicycle pedal of a particular cyclist. See *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989) cited in MPEP 2173.05(b).

The term "movable" in Claims 22 and 39 is vague and indefinite in the sense that things, which may be done, are not required to be done. For example, in Claim 22, the rear interlocking mechanism is movable, *but is not structurally required to be* moved from an interlocked position through an open position under stress from an elastic means. See "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), "crimpable" in *Application of Collier*, 158 USPQ 266 (CCPA 1968), "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

It is unclear whether a confusing variety of terms, such as, "a cyclist's shoe" and "a cycling shoe" in Claim 22 refers to the same or different things. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o).

No antecedent basis is seen for the terms, such as, "the *front* plate" and "the cycle bottom bracket shell" in Claim 22.

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15. Claim 22, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimano (US Patent No. 4,569,249 cited by Applicant).

Shimano teaches a cycle pedal comprising:

a pedal body 10 comprising a “rectangular” horizontal plate 10 having an upper surface (FIGS. 2 and 3);

means 20, 50, 51 for locking a cyclist's shoe disposed on the upper surface (FIG. 1, *id.* col. 3, line 60);

a case 16 (FIG. 2) containing a pedal pin 18 designed to be fixed to a free end of a crank (not shown, *id.* col. 3, lines 6-12), the case 16 being disposed on a longitudinal edge of the horizontal plate 10;

wherein the plate 10 is secured to the case 16 so that the upper surface extends beneath the pedal pin 18 along a distance (from an axis of the pin 18 to the upper surface of the plate 10 as seen in FIG. 2) and a support axis (not shown in FIG. 1) of the shoe (not shown) on the pedal plate 10 extends in front of the pedal pin 18 along a distance (not shown in FIG. 1), the support axis being defined as an axis merging with the front plate and passing through the metatarsus K₁-K₅ (FIG. 1) or K (FIG. 3) of a cyclist's big toe when said cyclist is pedalling with said cyclist's foot fitted in a cycling shoe interlocked with the cycle pedal (*id.* abstract, col. 3, line 6 through col. 4, line 14),

wherein the means for locking comprise:

a front interlocking mechanism 50 designed to co-operate with the front part of a clip (col. 3, line 60+) integral with the sole of the cyclist's shoe; and

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a *movable* rear interlocking mechanism 40 designed to co-operate with the rear part of the clip of the shoe, the *movable* rear interlocking mechanism 40 being *movable* under the pressure of the rear part of the clip of the shoe from a position called interlocked, and passing through an open position allowing to insert or remove the rear part of the clip of the shoe, until returning to the interlocking position under stress from an elastic means.

As noted, the term “a *movable* rear interlocking mechanism” in Claim 22 does not structurally require the rear interlocking mechanism to be moved. Therefore, Shimano’s rear interlocking mechanism 40 “reads on” the claimed “a movable rear interlocking mechanism.” Shimano teaches the invention substantially as claimed. However, Shimano does not explicitly teach the support axis described a circular curve with the center and radius downward and forward relative to the axis of the cycle bottom bracket shell.

It is common knowledge in the art to rearrangement of Shimano's parts such that the support axis described a circular curve with the center and radius downward and forward relative to the axis of the cycle bottom bracket shell in order to provide comfort to the foot of the cyclist. See legal precedents regarding rearrangement of parts in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrangement of Shimano's parts such that the support axis described a circular curve with the center and radius downward and forward relative to the axis of the cycle bottom bracket shell in order to provide comfort to the foot of the cyclist as taught or suggested by common knowledge in the art. The modification of Shimano’s pedal by rearrangement of the support axis would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere

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application of a known technique to a piece of prior art ready for the improvement." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR*, 127 S. Ct. at 1739.

16. Claim 22, as best understood, is further rejected under 35 U.S.C. 103(a) as being unpatentable over Shimano in view of Bernard et al. (USP 4,686,867).

Assuming *arguendo* that the term "a *movable* rear interlocking mechanism" in Claim 22 requires the rear interlocking mechanism to be moved:

Shimano teaches the invention substantially as claimed as seen in the rejection above. However, Shimano does not teach the movable rear interlocking mechanism.

Bernard teaches the bicyclist shoe having a clip 1 integral with a sole 4 in order to engage with the bicycle pedal 2 having a front interlocking mechanism 14 and a *movable* rear interlocking mechanism 18, 19 under stress from an elastic means 26 in order to facilitate the insertion or removal of the rear part of the clip of the shoe. Bernard, col. 1, line 13+.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the movable rear interlocking mechanism in Shimano's pedal in order to facilitate the insertion or removal of the rear part of the clip of the shoe as taught or suggested by Bernard.

17. Claims 26-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. Claims 39-41 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

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19. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Garnier (stud 9) and Peddis (pedal P).

21. Applicant's arguments filed on October 9, 2007; December 14, 2007; and March 24, 2008 have been fully considered but they are not persuasive.

In the amendment filed on October 9, 2007, Applicant contended that the schematic showing of the radial ribs in FIG. 9 would overcome the rejection under 35 USC 112, first paragraph.

The replacement drawings filed on October 9, 2007 were unacceptable since they are not in compliance with 37 CFR 1.121(d) and 1.84. Even if these drawings were in compliance with 37 CFR 1.121(d), 35 USC 113 states: “[d]rawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.”

On the other hand, the Examiner respectfully submits that the disclosure does not indicate that the functionally labeled box “RADIAL RIBS” in amended FIG. 9 filed on October 9, 2007 is “off-the-shelf” structure(s) and the disclosure fails to show how the various structures are interconnected with the claimed radial ribs. Therefore, the mere showing of a hollow rectangle with label “RADIAL RIBS” in amended FIG. 9 would not overcome the rejection under 35 USC

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112, first paragraph. See *In re Gunn*, 190 USPQ 402 (CCPA 1976) and *In re Donohue*, 193 USPQ 136 (CCPA 1977).

In view of the reasons set forth above, the objection to the drawings and the rejection under 35 USC 112, first paragraph, are respectfully maintained.

Applicant further contended that the amendments to the claims overcome the objection and rejection under 35 USC 112, second paragraph.

The amended claims and new claims are still indefinite and have the reference characters which are not enclosed by parentheses. Thus, the instant objection and rejection are likewise maintained.

Finally, the rejections under 35 USC 102 based on Giorgio and 103 based on Giorgio in view of Bernard are withdrawn in view of Applicant's amendments. Applicant's arguments regarding the previous art rejection are deemed to be moot.

For the foregoing, Applicant's request to allow the case is respectfully declined.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/

Primary Examiner, Art Unit 3682